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PATENT
Customer No. 22,852
Attorney Docket No. 05725.0533-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

ALAIN BETHUNE et al.)

Application No. 09/506,795)

Filed: February 18, 2000)

For: MATERIAL SUPPLY STRIP,
SYSTEM, AND METHOD OF
APPLYING PIECES OF
MATERIAL TO OBJECTS)

Group Art Unit: 1734

Examiner: K. Shortsle

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO OFFICE ACTION DATED JANUARY 2, 2002

In response to the Office Action dated January 2, 2002, Applicants respectfully request reconsideration and withdrawal of the claim rejections in view of the following remarks. Claims 1-75 are pending. Claims 7, 11, 13, 15, 17-19, 36-72, 74, and 75 have been withdrawn from consideration based on restriction and species election requirements.

In the Office Action, claims 1-6, 8-10, 12, 14, 16, 20-35, and 73 were rejected under 35 U.S.C. § 112, ¶ 1, as allegedly claiming subject matter not enabled by the specification. More specifically, the Examiner asserted that "the specification, while being enabling for applying at least one piece of material from each surface onto an object and applying pieces of material from each surface onto objects, does not

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reasonably provide enablement for applying one piece of material from either surface to a plurality of objects.” (Office Action at 3.) The Examiner further asserted that “Claim 1 does not limit the instance where one piece of material from the first surface is applied to a plurality of objects, and likewise applying material from the second surface to a plurality of objects, which is not enabled by the specification.” (*Id.*) Applicants respectfully disagree with this rejection because the full scope of claim 1 is enabled by the specification.

Under 35 U.S.C. § 112, ¶ 1, “[t]he determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry.” MPEP § 2164.08. In the first stage, the examiner must consider the entire claim “to determine how broad the claim is with respect to the disclosure.” *Id.* In the second stage, the examiner must “determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation.” *Id.* To satisfy the enablement requirement, “the scope of enablement must only bear a ‘reasonable correlation’ to the scope of the claims.” *Id.* “All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art.” *Id.* Moreover, “not everything necessary to practice the invention need be disclosed” and, “[i]n fact, what is well-known is best omitted.” *Id.*

Claim 1 recites a method of applying pieces of material to objects comprising, *inter alia*, “applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device,” and “applying at least one piece of material from the second surface of the backing to at least one object with said

at least one applicator device." As noted by the Examiner, claim 1 would cover, *inter alia*, the application of a single piece of material from the first and/or second surfaces of the material supply strip to a plurality (*i.e.*, two or more) of objects. Contrary to the Examiner's assertion, however, the specification would clearly enable one skilled in the art to practice this aspect of the invention recited in claim 1.

Applicants submit that the general concept of applying a single piece of material to two or more objects is clearly within the knowledge of one skilled in the art. This general concept could be implemented, for example, by positioning two or more objects adjacent to one another and applying an appropriately sized piece of material to two or more of the objects (*e.g.*, to label multiple objects and/or fix the objects together). Referring to the exemplary embodiment shown in Fig. 1 of the specification, a plurality of objects 8 (*e.g.*, two bottles) could be positioned side-by-side on a conventional conveyor and a piece of material 7 could be applied to two or more of the objects 8. Plainly, the full scope of claim 1 is enabled. For at least this reason, the rejection of claims 1-6, 8-10, 12, 14, 16, 20-35, and 73 under 35 U.S.C. § 112, ¶ 1 is improper and should be withdrawn.

Claims 1-6, 8-10, 12, 14, 16, 20-35, and 73 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. The Examiner asserted that "[i]t is unclear how one piece of material from the first surface is applied to a plurality of objects, and likewise it is unclear how a piece of material from the second surface is applied to a plurality of objects." (Office Action at 3-4.)

Applicants respectfully disagree with this rejection because these claims are not indefinite. In the discussion above, Applicants provided an example of how a single

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piece of material from the first and/or second surfaces of the supply strip might be applied to a plurality of objects. The pending claims comply with 35 U.S.C. § 112, ¶ 2. Therefore, Applicants respectfully request the Examiner to withdraw this rejection.

Claims 7, 11, 13, 15, 17-19, and 72 were withdrawn from consideration as being directed to non-elected species. Because each of these claims depend from allowable generic claims, Applicants respectfully request that the Examiner rejoin, examine, and allow each of these claims.

If a telephone conversation might advance prosecution of the application, the Examiner is invited to call Applicants' undersigned attorney at (202) 408-4197.

The Office Action contains characterizations of the invention, the claims, and the related art, with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17, which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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